REMARKS

Reconsideration of this application, as amended, is respectfully requested. Claims 1-37 are pending. Claims 1-37 were rejected.

In this response, claims 1, 7, 21, and 37 have been amended. Claim 5 has been canceled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicants submit that the amendments do not add new matter.

Applicants reserve all rights with respect to the applicability of the Doctrine of Equivalents.

Claim 7 has been objected to because of informalities.

Applicants have amended claim 7 to remove "e" in line 2.

Therefore, applicants submit that the Examiner's objection to claim 7, as amended, has been overcome.

Claims 1, 7-11, 21-22, 32, and 37 have been rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1, 4-9, 21-23, 34 and 35 of U.S. Patent No. 7,047,235 to Yang et al., ("Yang'235").

Claim 1 has been amended to include substantially all limitations of dependent claim 5 that were not part of the double patenting rejection. Claim 5 has been canceled.

Amended claim 1 includes "automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly."

In any event, it is respectfully submitted that the double patenting rejection is improper as the two inventions defined by the present application and Yang'235 are directed to and recite different subject matter. For example, claim 1 of Yang'235 reads as follows:

A computer-implemented method for retrieving medical images from <u>an existing image archive</u> and automatically creating at least one teaching file, comprising:
retrieving <u>at least one medical image and associated patient-specific information from the existing image archive;</u>
storing the retrieved medical image and associated information in a database;
automatically generating a database record for the at least one teaching file based upon the retrieved image and associated information;
<u>automatically generating the at least one teaching file based upon the automatically generated database record;</u>
storing the generated at least one teaching file into the database; and
generating at least one index of the stored teaching files.

(emphasis added)

In contrast, amended claim 1 of the present application reads as follows:

A method for retrieving medical images from <u>various sources and in different formats, to enable the creation of teaching files and research datasets, for the building of a personal medical image library</u>, the method comprising:
(a)   <u>directly retrieving a plurality of medical images from various sources;</u>
(b)   storing the plurality of medical images in a database;
(c)   generating a database record for the teaching files and research datasets;
(d)   <u>generating the teaching files and research datasets using at least one medical image of the plurality of medical images and additional information input by a user, the teaching files and research datasets being compliant with at least one predetermined schema;</u>
(e)   saving the teaching files and research datasets into the database;
(f)   generating at least one index of the teaching files and research datasets; and
(g)   <u>automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly.</u>

(emphasis added)

In comparing the claim 1 of the present application with claim 1 of Yang'235 it is readily apparent that the claims recite different inventions. The Examiner stated the following:

"A rejection based on the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discover any new and useful process …may obtain <u>a</u> patent therefor… (Emphasis added). Thus, the term "same invention", in this context, means an invention drawn to <u>identical subject matter</u>, see *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)."

(Office Action, p. 2) (emphasis added).

Notably, features in the preamble, sections (a), (d) and (g) of independent claim 1 of the present application are clearly not recited in the claim set of Yang'235. For example claim 1 of Yang'235 does not claim the features of claim 1 in this application recited in the preamble, sections (a), (d) and (g). Specifically, claim 1 Yang'235 does not recite a method for retrieving medical images from various sources and in different formats. Claim 1 of Yang'235 does not enable the creation of teaching files and research datasets, for the building of a personal medical image library. Claim 1 of Yang'235 does not recite feature (a) of directly retrieving a plurality of medical images from various sources. Claim 1 of Yang'235 does not recite feature (d) of generating the teaching files and research datasets using at least one medical image of the plurality of medical images and additional information input by a user, the teaching files and research datasets being compliant with at least one predetermined schema. Claim 1 of Yang'235 does not recite feature (g) of automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly.

Additionally, claim 1 of Yang'235 recites retrieving at least one medical image and associated patient-specific information from the existing image archive, storing the retrieved medical image and associated information in a database which is not specifically recited in claim 1 in this application.

Given that independent claims 21 and 37 of this application contain limitations that are similar to those limitations set forth above with respect to amended claim 1, applicants respectfully submit that claim 21 and 37 of the present application are non-identical to the claims of Yang'235 for the same reasons.

Therefore, as it is clear that the claims 1, 7-11, 21-22, 32 and 37 of the present application and claims 1, 4-9, 21-23, 34 and 35 of Yang'235 recite different inventions and are not identical, the claims 1, 7-11, 21-22, 32 and 37 of this application are patentably distinct from the claims 1, 4-9, 21-23, 34 and 35 of Yang'235 under 35 U.S.C. 101. Thus, the Examiner's double patenting rejection is invalid and should be removed.

Therefore, applicants respectfully submit that the Examiner's double patenting rejection of claims 1, 7-11, 21-22, 32 and 37 over claims 1, 4-9, 21-23, 34 and 35 of Yang'235 of Yang'235 under 35 U.S.C. 101 has been overcome.

Claims 21-37 have been rejected under 35 U.S.C §101 as allegedly being directed to non-statutory subject matter.

Applicants respectfully disagree.

Amended claim 21 reads as follows:

> An apparatus for retrieving medical images from various sources and in various formats for creating at least one teaching file and research dataset; the apparatus comprising:
> a database for storing the at least one teaching file and research dataset in a generated database record, an image retrieval interface configured to directly retrieve medical images from various sources and in different formats,
> an MIRC server configured to provide an MIRC file storage service for the database and for a user's machine automatically anonymizing patient identification data based upon the at least one medical image retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly,
> a graphic user interface for operation on a user's machine to communicate with the MIRC server; and
> a web server to service requests from the graphic user interface.

(emphasis added).

The Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C §101 dated August 24, 2009 ("Instructions") which supersede previous guidance on subject matter eligibility that conflicts with the Instructions, including MPEP 2106(IV), 2106.01 and 2106.02, require that claim "must be directed to one of the four statutory categories… [that]

includes [a] mechanical device .. to perform some function and produce certain effect or result."
(pp. 1-2).

Claim 21 recites an apparatus including hardware components such as a database <u>for storing</u>, an MIRC <u>server</u> configured to provide an MIRC file <u>storage</u> service, a graphic user interface for operation <u>on a user's machine;</u> and a web <u>server to service requests</u>. Applicants submit that a database <u>for storing</u>, an MIRC <u>server</u> configured to provide an MIRC file <u>storage</u> service, a graphic user interface for operation <u>on a user's machine;</u> and a web <u>server to service requests</u> are clearly patentable subject matter under 35 U.S.C §101 according to the Instructions.

Therefore, applicants respectfully submit that the Examiner's subject matter eligibility rejection of claim 21 under 35 U.S.C §101 has been overcome.

Given that claims 22-36 depend from amended claim 21, and add additional limitations, applicants respectfully submit that the Examiner's subject matter eligibility rejection of claims 22-36 under 35 U.S.C §101 have been overcome.

Claim 37 has been amended to "A computer <u>readable storage</u> medium..." The preamble of claim 37, as amended, clearly defines patentable subject matter according to the Instructions. Further, it is submitted that claim 37 recites a "machine" that meets the M-or-T test as defined in Section II on page 6, second full paragraph of the Instructions.

Therefore, applicants respectfully submit that the Examiner's subject matter eligibility rejection of claim 37 under 35 U.S.C §101 has been overcome.

Claims 1-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,374,077 to Shimura ("Shimura") and further in view of U.S. Patent No. 7,080,098 to Smirniotopoulos ("Smirniotopoulos").

Amended claim 1 reads as follows:

A method for retrieving medical images from various sources and in different formats, to enable the creation of teaching files and research datasets, for the building of a personal medical image library, the method comprising:

(a) directly retrieving a plurality of medical images from various sources;

(b) storing the plurality of medical images in a database;

(c) generating a database record for the teaching files and research datasets;

(d) generating the teaching files and research datasets using at least one medical image of the plurality of medical images and additional information input by a user, the teaching files and research datasets being compliant with at least one predetermined schema;

(e) saving the teaching files and research datasets into the database;

(f) generating at least one index of the teaching files and research datasets; and

(g) <u>automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly</u>.

(emphasis added)

Shimura discloses an image search system which searches for images similar to an image to be diagnosed among a number of images. The system of Shimura teaches searching for similar images by using object part information relating to the image and personal information representing the name, age, sex, and/or the like of the patient, and disease information representing the disease represented by the image (col. 2, line 57 to col. 3, line 15).

The Examiner acknowledged that "Shimura does not explicitly disclose... automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources."(Office Action, p. 9). Further, the Examiner acknowledged that "Shimura does not disclose anonymizing patient sensitive information..."(Office Action, p. 10)

Accordingly, Shimura fails to disclose automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly, as recited in amended claim 1.

Further, Shimura does not disclose or teach retrieving medical images from various sources, particularly medical images in different formats, to enable the creation of teaching files and research datasets, for the building of a personal medical image library, comprising: (a) directly retrieving a plurality of medical images from various sources, as recited in amended claim 1. Shimura fails to disclose or teach generating the teaching files and research datasets using at least one medical image of the plurality of medical images and additional information input by a user, the teaching files and research datasets being compliant with at least one predetermined schema, as recited in amended claim 1.

Additionally, Shimura, as indicated by the Examiner, merely discloses the image input receives input from a plurality of client terminals (as sources) connected to the image input means by way of a network (col. 2, lines 49-52). Nowhere does Shimura disclose or teach directly retrieving a plurality of medical images from various sources, as recited in amended claim 1.

Smirniotopolous, in contrast, discloses a medical multimedia database system. The system of Smirniotopolous merely discloses a web-based system that allows users to login and create cases with medical images. These cases are managed by a database system. More specifically, Smirniotopolous discloses supporting multiple levels of privileges for access logon, "for example, … the full ability to create a new file,…not have privileges to edit modifications (col. 3, lines 30-47). In contrast, amended claim 1 refers to automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources, as recited in amended claim 1. Smirniotopolous fails to disclose automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly, as recited in amended claim 1.

It is respectfully submitted that Shimura does not teach or suggest a combination with Smirniotopoulos, and Smirniotopoulos does not teach or suggest a combination with Shimura. It would be impermissible hindsight, based on applicants' own disclosure to combine Shimura and Smirniotopoulos.

Furthermore, even if the medical multimedia database system of Smirniotopoulos were incorporated into the image search system of Shimura, such a combination would still lack automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly, as recited in amended claim 1.

Therefore, applicants respectfully submit that claim 1, as amended, is not obvious under 35 U.S.C. 103(a) over Shimura in view of Smirniotopoulos.

Given that claims 2-37 contain limitations that are similar to those limitations set forth above with respect to amended claim 1, applicants respectfully submit that claims 2-37 are not obvious under 35 U.S.C. §103(a) over Shimura in view of Smirniotopoulos.

Claims 24-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shimura and further in view of U.S. Publication No. 2003/0013951 to Stefanescu("Stefanescu").

Stefanescu, in contrast, discloses organizing and searching database of medical images. Stefanescu fails to disclose or suggest an MIRC server configured to provide an MIRC file storage service for the database and for a user's machine automatically anonymizing patient identification data based upon the at least one medical image retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly, as recited in amended claim 1.

It is respectfully submitted that none of the references cited by the Examiner teach or suggest a combination with each other. It would be impermissible hindsight, based on applicants' own disclosure to combine Stefanescu, Shimura and Smirniotopoulos.

Furthermore, even if the database organization and searching of Stefanescu and medical multimedia database system of Smirniotopoulos were incorporated into the image search system of Shimura, such a combination would still lack <u>automatically anonymizing patient identification data when the at least one medical image is retrieved from the various sources, wherein the patient identification data comprises patient sensitive information that is not revealed publicly,</u> as recited in amended claim 21.

Given that claims 24-28 depend from amended claim 21, and add additional limitations, applicants respectfully submit that claims 24-28 are not obvious under 35 U.S.C. §103(a) over Shimura in view of Smirniotopoulos.

It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If the Examiner believes a telephone conference would assist in the prosecution of the present application, the Examiner is invited to call the undersigned.

If there are any additional charges, please charge Deposit Account No. 022666 for any fee deficiency that may be due.

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Respectfully submitted,
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